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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,789	07/10/2000	Satyan G. Pitroda	2683/79382	9381

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EXAMINER

TRINH, TAN H

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 09/17/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/612,789

Applicant(s)

PITRODA, SATYAN G.

Examiner

TAN TRINH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-4 and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Dent (U.S. Patent No. 6,311,171).

Regarding to claim 1, Regarding to claim 1, Dent teaches a method of exchanging payment information in an electronic transaction, comprising:

a) a first electronic transaction device transferring payment information to a second electronic transaction device (See fig. 1, first electronic transaction device's item 11 (Customer smart card) and second electronic transaction device's item 13 (merchant's point-of-sale terminal), col. 3, lines 59-col. 4, lines 16).

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b) the second electronic transaction device transferring value information to the first electronic transaction device (See fig. 1, first electronic transaction device's item 11 (Customer smart card) and second electronic transaction device's item 13 (merchant's point-of-sale terminal), col. 3, lines 59-col. 4, lines 16).

c) the second electronic transaction device transferring value information and payment information to a service consolidation center (see fig. 1, second electronic transaction device's item 13 (merchant's point-of-sale terminal) and information to a service consolidation center item 10 (virtual bank), col. 3, lines 59-col. 4, lines 16) and (fig. 2, col. 5, lines 45-51, and col. 5, lines 10-31).

Regarding to claims 2-4, Dent teaches the value information comprises a virtual card (see fig. 1, item 11 (Customer smart card) and col. 3, lines 59-67), authorization code (see abstract, lines 4-7 and col. 4, lines 33-38), and image of a card (see col. 4, lines 38-63).

Regarding to claim 6, Dent teaches the payment information comprises cash payment information (see fig. 1, Please pay \$13).

Regarding to claim 7, Dent teaches the cash payment information includes an identification of a person providing a cash payment (see fig. 2, col. 5, lines 10-31).

Regarding to claim 8, Dent teaches the payment information comprises credit payment information (see col. 5, lines 34-43).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5, 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dent (U.S. Patent No. 6,311,171) in view of Fougnyes (U. S. Pub. No. 20010021648).

Regarding to claim 5, Dent teaches the value information of smart card. But Dent fails to teach a quantity of minutes corresponding to a pre-paid telephone account.

However, Fougnyes teaches the card type identify whether the card is air-time credit or monthly access credit, the POS device checks to see the pre-paid card has been used or the minute is spent (see page 7, section 0058] and section [0059].

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Dent system and the teaching of Fougnyes on the pre-paid card air time minute technique, thereto in order to provide user to check the credit of pre-paid card easier.

Regarding to claim 9, Dent teaches the method of exchanging payment information in an electronic transaction, but Dent fails to show the method of tracking retail sales of pre-paid cards to cash subscribers.

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However, Fougnyes teaches the method of tracking retail sales of pre-paid cards to cash subscribers. (see page 6, section [0058]) comprising:

a); an entering value purchased information and subscriber information in a retailer electronic transaction device (see page 7, section [0059] and page 7, section [0066],

b) the retailer electronic transaction device transferring the value purchased information and subscriber information to a mobile operator (see page 7, section [0068], lines 1-3),

c) the mobile operator adding value corresponding to the value purchased information to an account corresponding to the subscriber information (see page 7, section [0068], lines 14-18) page 8, section [0070] and page 7, section [0063]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the Dent system with the providing of the teaching of Fougnyes in the pre-paid cards technique there to in order to provide user with convenient to pay monthly access fees and to purchase additional air time with pre-paid cards.

Regarding to claim 10, Dent teaches the step of entering value purchased information and subscriber information in a retailer electronic transaction device further comprises electronically transferring the value purchased information and subscriber information from a MO subscriber handset to the retailer electronic transaction device (See fig. 1, first electronic transaction device's item 11 (Customer smart card) and second electronic transaction device's item 13 (merchant's point-of-sale terminal), col. 3, lines 59-col. 4, lines 16).

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Regarding to claim 11, the step of entering value purchased information and subscriber information in a retailer electronic transaction device further comprises manually entering the value purchased information and subscriber information into the retailer electronic transaction device. This is obvious to the electronically transfer, so that the entering value purchased information and subscriber information in a retailer electronic transaction can be flexibility.

Regarding to claim 12, Dent teaches a method of distributing virtual pre-paid cards (see fig. 1, and col. 4, lines 39-65) comprising:

a), creating virtual transaction card, like the virtual bank using public key or smart card or electronic wallet, which include the integrated processor and memory chip having an external I/O interface through the processor, and the function is storing virtual cash (see fig1, and col. 3, lines 60-67, and col. 4, lines 42-63).

b), downloading the virtual pre-paid card to the retail electronic transaction device (See fig. 1, first electronic transaction device's item 11 (Customer smart card) and second electronic transaction device's item 13 (merchant's point-of-sale terminal), col. 3, lines 59-col. 4, lines 16).

c), transferring virtual pre-paid card from the retail electronic transaction device to MO subscriber handset (see fig. 2, col. 5, lines 9-31 and col. 3, lines 60-64).

However, The virtual cash card or the smart card used to purchase merchandise at a store that is obvious to the pre-paid card (see col. 3, lines 66-67), so that the user can shop easily and convenient without carry the cash.

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Regarding to claim 13, Dent teaches the step of transferring payment information from the MO subscriber handset to the retailer electronic transaction device (see fig. 1, Please pay \$13).

Regarding to claim 14, Dent teaches the step of creating a virtual card is performed by an electronic transaction device service center (see fig. 1 item 10 virtual bank).

Regarding to claim 15, Dent teaches the steps of transferring payment information and subscriber information from the MO subscriber handset to the retailer electronic transaction device; and transferring the payment information and subscriber information from the retailer electronic transaction device to the electronic transaction device service center (See fig. 1, MO subscriber handset item 11 and electronic transaction device's item 13 and the electronic transaction device service center item 10 (virtual bank), col. 3, lines 59-col. 4, lines 16) and (fig. 2, col. 5, lines 45-51, and col. 5, lines 10-31).

Regarding to claim 16, Fougny teaches the steps of downloading the virtual card to a retailer electronic transaction device occurs via a MO switch (see fig. 1 item 20 L.E.C and fig. 8A-B cellular switch 204 and page 8, section [0051]).

5. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dent (U.S. Patent No. 6,311,171) in view of Fougny (U. S. Pub. No. 20010021648) further in view of Tushie (U.S. Patent No. 6,202,155).

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Regarding to claim 17, Dent or Fournies fails to teach the step of downloading batches of virtual transaction cards to the retailer electronic transaction device.

However, Tushie teaches the step of creating a virtual card comprises creating a plurality of virtual cards and the step of downloading the virtual card to a retailer electronic transaction device comprises downloading batches of virtual transaction cards to the retailer electronic transaction device (see figs. 1-2 and 6A-B, col. 1, lines 29-40, col. 2 lines 51-67 and col. 3 lines 1-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Dent and Fournies systems and by the providing of the teaching of Tushie on the downloading batches of virtual transaction cards technique thereto in order provide the issuer to identify the easier.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Paltenghe (U.S. Pub. No. 200200044783) discloses virtual wallet system.

Ung (U.S. Pub. No. 20030069819) discloses prepaid real-time web based reporting.

Titus (U.S. Pub. No. 20020029189) discloses prepaid short messaging.

Verkama (U.S. Pub. No. 20010005840) discloses authentication in a telecommunications network.

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7. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for Technology Center 2600 only)

*Hand-delivered responses should be brought to Crystal Park II,
2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).*

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Trinh whose telephone number is (703) 305-5622. The examiner can normally be reached on Monday-Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung, can be reached at (703) 308-7745.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Technology Center 2600 Customer Service Office** whose telephone number is **(703) 306-0377**.

Tan H. Trinh

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September 2, 2003

